

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

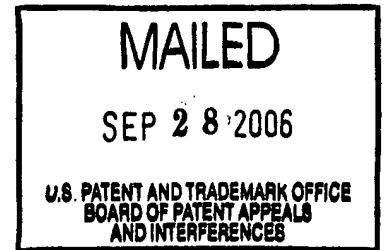
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEVON DAVID CULLUM

Appeal No. 2006-1984
Application No. 09/296,676¹

ON BRIEF



Before BLANKENSHIP, SAADAT, and HOMERE, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 2-5, 7-25, 35 and 36. Claims 1, 6 and 26-34 have been cancelled.

We affirm.

BACKGROUND

Appellant's invention relates to an anti-theft device to be used in an electronic apparatus. According to Appellant, a remote intelligent communications (RIC) unit included in the

¹ Application for patent filed April 22, 1999.

device receives a shut-off signal from an interrogator which uses satellite link or other channels to send a disable signal to the apparatus (specification, page 3). The signal is received in a shut-off unit which when disabled, may prevent a flow of electricity and shut down the device (id.).

Representative independent claim 35 is reproduced as follows:

35. An anti-theft device cooperatively operable with normal utilization circuits within an electronic apparatus, comprising:

a remote intelligent communication (RIC) unit configured for enablingly coupling with the normal utilization circuits, the RIC unit, including:

a control circuit including:

a memory configured to receive and store therein a unique identifier of a specific one of the electronic apparatus;

means for inputting the unique identifier into the memory at a point of sale; and

a transceiver configured to at least receive a signal; and

a shut-off unit configured for entering a shut-off state and disabling operative power via a shut-off signal to the normal utilization circuits in response to receipt of the signal via the transceiver of a shut-off command designating the unique identifier stored in the RIC unit.

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The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Glenn	5,406,261	Apr. 11, 1995
Sheffer	5,515,419	May 7, 1996
Isikoff	5,748,084	May 5, 1998
Chan et al. (Chan)	5,850,445	Dec. 15, 1998
Sharpe	6,094,146	Jul. 25, 2000 (filed Jul. 9, 1997)
Bishop	6,664,888	Dec. 16, 2003 (effectively filed Dec. 16, 1997)

Claims 2-5, 7-15, 19-25, 35 and 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Isikoff, Bishop and one of Sharpe or Chan.

Claims 16 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Isikoff, Bishop and one of Sharpe or Chan and further in view of Sheffer.

Claim 18 stands rejected under 35 U.S.C. § 103 as being unpatentable over Isikoff, Bishop and one of Sharpe or Chan and further in view of Glenn.²

Rather than reiterate the opposing arguments, reference is made to the briefs and the answer for the respective positions of

² As indicated in the answer (Page 9), the Examiner has withdrawn the 35 U.S.C. § 112, first paragraph rejection of claims 2-5, 7-25, 35 and 36.

Appellant and the Examiner. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the briefs have not been considered (37 C.F.R. § 41.37(c)(1)(vii)).

OPINION

With respect to the rejection of claims 2-5, 7-15, 19-25, 35 and 36, Appellant argues that the teachings of Sharpe and Chan show that the disclosed devices in their unprogrammed state are not disabled but rather ignore the broadcast messages (brief, pages 15-16). Appellant further points out that there is no motivation for combining the references and only hindsight has been used to reconstruct the claimed invention (brief, pages 16-17; reply brief, pages 5-8).

In response, the Examiner states that the claims merely require that the RIC unit be enabled to couple with the normal circuits upon programming, and not be disabled prior to programming (answer, page 9). Furthermore, the Examiner asserts that the device described in Sharpe, although may ignore messages until the RIC is programmed, does become enabled after being programmed to receive messages (id.). The Examiner further points out that specific portions of Bishop have been relied on for teaching a shut-off state responsive to a shut-off command designating the unique identifier (answer, page 10).

As a general proposition, in rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). However,

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the motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

A review of the applied prior art references confirms our view that the Examiner's analysis is sufficiently reasonable to satisfy the burden of presenting a prima facie case of obviousness. The burden is, therefore, upon Appellant to come forward with evidence and/or arguments which persuasively rebut the Examiner's prima facie case. Here, Appellant merely discusses the teachings of Sharpe and Chan whereas the Examiner has primarily relied on Bishop and Isikoff for teaching the disabling features of the anti-theft device.

In particular, after reviewing Bishop and Isikoff, we remain unpersuaded by Appellant's argument regarding the absence of the claimed shut-off state in response to a command designated by the unique identifier in Sharpe or Chan. As pointed out by the Examiner (answer, page 10), these features were identified in other prior art references as the basis for the obviousness rejection has been the combination of Bishop and Isikoff with Sharpe or Chan. To show nonobviousness, one may not attack

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references individually where the rejection is based on combination of references. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Additionally, in this case the reason for combining the references has been articulated by the Examiner (answer, page 4) as the desirability of isolating the main circuit from the shut-off unit for added disabling capability. Additionally, the Examiner has identified prevention of unauthorized use of the device prior to purchase as the reason for entering the specific ID at the point of sale, as taught by Sharpe and Chan, which applies to any coded device that may allow the customer to select a personal identification number (answer, page 5). While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination (see B.F. Goodrich Co. v. Aircraft Braking Systems Corp., 72 F.3d 1577, 1583, 37 USPQ2d 1314, 1319 (Fed. Cir. 1996) and In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)) as Appellant would apparently have us believe. Rather, the test for obviousness is what the combined teachings of the references would have suggested to one

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of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one of ordinary skill in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Therefore, based on the overall disclosures, teachings, and suggestions of the prior art and the level of skill in the art, we remain unpersuaded by Appellant's arguments that any error in the Examiner's determination regarding the obviousness of the claimed subject matter has occurred. Accordingly, as the Examiner has established a prima facie case of obviousness with respect to the independent claims and Appellant did not present persuasive evidence or argument in rebuttal, see In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984), we sustain the 35 U.S.C. § 103(a) rejection of claims 11, 35 and 36 as well as 2-5, 7-10, 12-15 and 19-25, dependent thereon, over Isikoff, Bishop and one of Sharpe or Chan.

With respect to the rejection of the remaining claims, we note that the Examiner further relies on Sheffer and Glenn for the additional features recited in the these dependent claims.

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However, Appellant merely repeats the claim language and relies on the arguments previously presented with respect to their base claims. It is held that merely repeating the claim limitations with no attempt to point out how the claims patentably distinguish over the prior art cannot be considered as separate argument for patentability. In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, we sustain the 35 U.S.C. § 103 rejection of claims 16 and 17 over Isikoff, Bishop and one of Sharpe or Chan in combination with Sheffer, as well as of claim 18 over Isikoff, Bishop and one of Sharpe or Chan in combination with Glenn.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 2-5, 7-25, 35 and 36 under 35 U.S.C. § 103 is affirmed.

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